

### **REMARKS**

In response to the Office Action mailed March 5, 2007, Applicant submits this Amendment accompanied by a petition for a one-month extension of time. As a result of this Amendment, claims 1-4 and 6-24 are pending. Upon the electronic submission of this paper, Applicant's representative authorized a charge to Deposit Account No. 13-2855 covering the petition fee and an extra claims fee for two new dependent claims.

Applicant believes that no additional fees are necessary for the proper entry and consideration of this Amendment. Nevertheless, if the Office deems otherwise, kindly charge any costs thereof to Deposit Account No. 13-2855, Order No. 30810/39676A.

In light of the foregoing amendments to the claims and the following remarks, Applicant believes that the present application is in condition for allowance and respectfully requests the Examiner to acknowledge the same.

### **DRAWING OBJECTIONS**

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "19" has been used to designate "purified air," "cleaned air," "separate exit" and "exit."

Applicants submit that various portions of the specification have been amended herein to clarify that reference character "19" is designated to the exits of the filter elements 16, as depicted in FIGS. 3-7. Moreover, with respect the objection to the use of reference character "19" as also being designated to a "separate exit," Applicant submits that the use of the term "separate" is merely explanatory. For example, as recited in the third full paragraph of page 8 of the originally filed specification, the term "separate" is merely used to described that each filter element 16 may have its own exit 19.

Accordingly, Applicant submits that such designation is properly descriptive and kindly requests reconsideration and withdrawal of this drawing objection.

The drawings further stand objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "13" and "42."

Applicant respectfully submits that reference character “13” is provided in FIGS. 1 and 2 and reference character “42” is provided in FIGS. 3 and 4.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this outstanding drawing objection.

### **CLAIM OBJECTIONS**

Claims 1-4 and 6-22 stand objected to because the office action alleges that these claims do not consistently denote the person who operates the breathing apparatus.

Applicant has amended claims 3 and 10 to replace the term “wearer” with “user.” Accordingly, reconsideration and withdrawal of these outstanding objections is respectfully requested.

### **REJECTIONS UNDER 35 U.S.C. §112**

Claims 1-4, 6-8, 14 and 17-19 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention.

Particularly, the office action rejects the use of the following phrases in various claims: “and/or,” “filter/canister system,” “filter/decontamination system,” and “means.”

Applicant submits that claims 1, 2, 4, 8, 14, 18, and 19 have been amended to overcome these rejections. Particularly, the phrase “and/or” has been eliminated from the claims, the phrases “filter/canister system” and “filter/decontamination system” have been revised to state “filter system,” and the “means” limitations have been revised to properly recite “means for...” in accordance with 35 U.S.C. §112, paragraph six.

Reconsideration and withdrawal is respectfully requested.

### **REJECTIONS UNDER 35 U.S.C. §103**

Claims 1-4 and 6-22 stand rejected under 35 U.S.C. §103 as allegedly obvious over Kimm et al. (U.S. Patent No. 5,161,525) in view of Yagi et al. (U.S. Patent No. 7,077,133). Applicant respectfully traverses these obviousness rejections.

*A prima facie* case of obviousness requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references themselves or in

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when combined, must teach or suggest all of the claim limitations. *See* M.P.E.P. §2143.

Applicants submit that such criteria have not been satisfied, and that each of claims 1-4 and 6-22 is allowable over Kimm et al. and Yagi et al., either alone or in combination.

*Failure to Teach All Claimed Limitations*

Initially, as amended, the claims of the present application more clearly recite a breathing apparatus having, in part, two distinct modes: a clean air mode and a filter air mode. A first switch switches between the two modes.

Neither Kimm nor Yagi disclose a breathing apparatus having a filtered air mode and a clean air mode. Rather, both Kimm and Yagi disclose ventilation systems for providing a patient with breathing air from a single source. Kimm provides a continuous supply of an air/oxygen mixture from two tanks 12, 14 in an open-circuit system having a filter assembly 38 downstream of the patient for filtering bacteria from a patient's exhalation. Yagi provides a continuous supply of oxygen-enriched gas obtained from the atmosphere. While both Kimm and Yagi disclose systems that adjust the flow rate of the continuous supplies, neither has two modes nor switches between two different sources of supply. Therefore, neither Kimm nor Yagi, alone or in combination, teach each and every element of the claims of the present application and the obviousness rejections should be withdrawn.

*Lack of Motivation to Combine*

Moreover, the combination of Kimm and Yagi is improper for a multitude of reasons. First, there is no motivation to modify the device of Kimm to include an alternative air source, i.e., a filter assembly, such that the device may be switched between the filter assembly and the tanks 12, 14. Rather, as stated above, Kimm discloses a system having a single source of air, i.e., a mixture from the tanks 12, 14, providing a continuous supply. Similarly, Yagi discloses a system having a single source of air, i.e., the oxygen-enriching system, providing a continuous supply. Nothing suggests any reason to add another, alternative, source to the devices disclosed in Kimm and Yagi.

*Combination Renders Primary Reference Inoperable for Intended Purpose*

Furthermore, any modification of Kimm, as suggested in the Office Action, would render the device of Kimm inoperable for its intended purpose. Kimm concerns a ventilation device for providing pressure supported breaths for a patient. Kimm discloses that the device advantageously provides a continuous air supply from the air and oxygen tanks 12, 14. This continuous air supply is disclosed as being critical for eliminating lag time between pressure supported breaths and for reducing a patient's inspiratory efforts. (See, Col. 3, lines 52+). If the device of Kimm were modified to switch between a supply of air/oxygen from the tanks 12, 14 and, alternatively, a supply of filtered air from the filter assembly 38, as suggested by the Examiner, the device could not provide a continuous supply of air/oxygen without substantial modification, the details of which are not taught by the prior art, but can only be gleaned from Applicant's own disclosure, which would thereby result in impermissible hindsight. Thus, the device of Kimm could no longer serve its intended purpose.

Notwithstanding the foregoing arguments, Applicant has made minor amendments to independent claims 1 and 9 to more particularly point out and distinctly claim the subject matter of the present application. Specifically, claims 1 and 9 have been amended to more clearly recite that the breathing apparatus has two modes, i.e., a clean air mode and a filtered air mode, and a switch for switching between the two modes. The switch being the regulator valve, which when opened, allows pressurized air to flow from the compressed air tank and actuate the valve assembly from the filtered air mode to the compressed air mode. Neither of the cited references disclose such a feature, nor provide the necessary motivation to arrive at such an arrangement.

**NEW CLAIMS**

New claims 23 and 34 have been added herein. Applicants submit that claims 23 and 24 are dependent on allowable claims 1 and 9, respectively, and as such, are also in condition for allowance.

**PROVISIONAL DOUBLE PATENTING REJECTION**

Applicant respectfully traverses the rejection of claims 1-4, 6-10, and 13-20 for obviousness-type double patenting over the parent application, U.S. Patent Application Serial

No. 10/393,346. Reconsideration and withdrawal of the provisional rejection is respectfully requested.

First of all, Applicant submits that the obviousness-type double patenting rejection is improper, as the claims in the present application include limitations not found in the claims of the parent application, and which makes these claims non-obvious for at least the reasons stated above with respect to the cited prior art. That is, the claims of the present application are not “generic” claims with respect to “species” claims found in the parent application. The obviousness-type double patenting is therefore improper.

Additionally, Applicant submits that, if the claims of the present application are “generic” claims to “species” claims found in the parent application, the present obviousness-type double patenting rejection is still improper in the present application pursuant to MPEP §§ 804 and 1490. In particular, MPEP § 1490 states that, where two applications have the same priority date (as is the case in this situation as both the present application and the parent application have the same effective filing date), an obviousness-type double patenting rejection is not properly applied to the application which claims the “base” (i.e., generic) invention. Instead, the obviousness-type double patenting rejection is properly applied to the application which claims the additional limitations. In particular:

*If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP [obviousness-type double patenting] rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.*

MPEP § 1490 (emphasis in original).

In this case, Applicant submits that the present application is the base application as the broadest claims of the present application contain fewer limitations than the claims now present in the parent application. In fact, the Examiner has indicated as much in the Office Action. For this further reason, the obviousness-type double patenting rejection is improper in this case.

For these reasons, applicant respectfully requests the Examiner to withdraw the obviousness-type patenting rejection in this case.

### **CONCLUSION**

In view of the foregoing, Applicant submits that each of the outstanding objections, rejections, and/or other concerns have been either accommodated, traversed, or rendered moot, thereby placing the present application in condition for allowance. If there are any outstanding issues that the Examiner believes may be remedied via telephone conference, Applicant invites the Examiner to telephone the undersigned at (312) 474-6300.

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Respectfully submitted,

By

  
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